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| 10/815,785      | 04/02/2004  | Nicola Leone         | T8-467921US         | 9935             |

7590 10/11/2005

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CANADA

EXAMINER

GARCIA, ERNESTO

ART UNIT PAPER NUMBER

3679

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Office Action Summary*

Application No.

10/815,785

Applicant(s)

LEONE ET AL.

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 12-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/20/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election of Species***

This application contains claims directed to the following patentably distinct species of the claimed invention:

- |                          |              |
|--------------------------|--------------|
| I. Figures 1-4, 8, and 9 | II. Figure 5 |
| III. Figure 6            | IV. Figure 7 |

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 2 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. Arne Fors on September 29, 2005 a provisional election was made with oral traverse to prosecute the invention of species I, claims 1-4. Applicant in replying to this Office action must make affirmation of this election. Claims 9-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Drawings***

The drawings are objected to because the cross-sectional view, Fig. 3, is not correct. Where the plane is taken in Figure 2, should not make the inserts entirely solid as shown in Figure 3. Therefore, the cross-hatching of the inserts in Figure 3 should not be partially hatched.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the insert and the picket fence being plastic (claim 21) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled

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"Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The language should avoid using phrases, which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes", "This invention relates to", etc.

### ***Claim Objections***

Claims 2-4, 15, 20-23, and 27 are objected to because of the following informalities:

regarding claim 2, "each" in line 1 should be deleted as the claim is directed to one ornamental insert, and "ornamental insert" in line 1 should be --body--;

regarding claim 3, "openings" in line 1 should be --opening--, and "ornamental insert" in line 2 should be --body--;

regarding claim 4, a comma needs to be inserted after "space" in line 7;

regarding claim 15, "comprising/having" in line 8 should be --comprising--;

regarding claims 20 and 21, "or trellis" in lines 1 and 2 should be deleted;

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regarding claims 22 and 23, "ornamental fence insert for a" in line 1 should be deleted as the subject matter of claim 15 is to the picket fence; and,

regarding claim 27, "surface" in line 2 should be --surfaces--, "side" in line 2 should be --sides--, and a period is need after "perimeter" in line 4. Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 5-7, 13, 20, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the claim further sets to define the opening, which is not part of the ornamental insert. How does further limiting the opening further limit the ornamental insert?

Regarding claim 5, there is an inconsistency between the language in the preamble and a certain portion in the body of the claim, thereby making the scope of the claims unclear. The preamble clearly indicated that the ornamental fence insert is "for a

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picket fence". However, the body of the claim positively recites "the intermediate rail", and "the top rail", e.g., "said downwardly facing abutment surface is seated on said intermediate rail top surface and said upwardly facing abutment surface is in abutment with the top rail bottom surface" (lines 2-3), which indicates that the claims are being drawn to a combination of the "ornamental fence insert" and both "the intermediate rail and the top rail". Accordingly, is the combination or subcombination being claimed? Appropriate correction, clarification, or both is required.

Regarding claims 6 and 7, the claims depend from claim 5 and therefore are indefinite.

Regarding claim 13, the metes and bounds of the claim is unclear. In particular, the claim sets to define a method of using the ornamental fence insert of claim 4, yet no active method steps have been recited.

Regarding claims 20 and 21, the metes and bounds of the claims is unclear. The claims set to further limit the picket fence, which is not part of the ornamental fence insert. How does the picket fence being metal or plastic further limit the ornamental fence insert?



***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Krauser, 7,774.

Regarding claim 1, Krauser discloses, in Figure 1, an ornamental insert comprising a body **A1** having a perimeter **A2**, and brackets **n** projecting from the perimeter **A2** from diametrically opposite sides **A4** of the body **A1**. Each of the brackets **n** has a pair of opposed sidewalls **A5**.

Regarding claim 2, the body **A1** has abutment surfaces **A6** formed on the perimeter **A2** on diametrically opposite sides **A7** of the body **A1** between the brackets **n** and equi-spaced from the brackets **n**.

Regarding claim 3, the body **A1** is selected from the group consisting of circular, astroidal, diamond-shaped, cross-shaped, and elliptical-shaped inserts.

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Claims 4-8, 12-14, 20, and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Hainsworth, 386,124 (see marked-up attachment).

Regarding claim 4, Hainsworth discloses, in Figure 3, an ornamental fence insert comprising a body **A1** having a perimeter **A2** and brackets **C**. An upwardly facing abutment surface **A8** and a downwardly facing abutment surface **A9** are formed on the perimeter **A2**. The brackets **C** project outwardly and horizontally from the perimeter **A2** of diametrically opposite sides **A4** of the body **A1**. Each of the brackets **C** has a pair of opposed sidewalls **A5** defining a u-shape.

Regarding claim 5, the upwardly facing abutment surface **A8** is seated on a rail top surface **A10** and the downwardly facing abutment surface **A9** is in abutment with a top rail bottom surface **A11**.

Regarding claim 6, the sidewalls **A5** are joined by a web **A12**.

Regarding claim 7, each of the sidewalls **A5** overlaps a surface **A13** of one picket **A14** in a direction of a horizontally extending direction of rails **A15**.

Regarding claim 8, the body **A1** is substantially circular-shaped.

Regarding claim 12, the body **A1** is substantially elliptical-shaped.

Regarding claim 13, Hainsworth discloses the use of the ornamental fence insert in a picket fence having equispaced pickets and parallel rails secured to the pickets defining an opening with a pair of adjacent pickets.

Regarding claim 14, Hainsworth discloses a picket fence having an ornamental insert comprising a body **A1** having a perimeter **A2** and brackets **C**. An upwardly facing abutment surface **A8** and a downwardly facing abutment surface **A9** are formed on the perimeter **A2**. The brackets **C** project outwardly and horizontally from the perimeter **A2** of diametrically opposite sides **A4** of the body **A1**. Each of the brackets **C** has a pair of opposed sidewalls **A5** defining a u-shape.

Regarding claim 20, the insert is metal.

Regarding claim 26, Hainsworth discloses, in Figs. 1, 3, and 4, a trellis comprising a pair of parallel, spaced-apart rails **A14**, transverse equispaced pickets **A15**, and an ornamental insert (Fig. 3). The pickets **A15** extend between the rails **A14** and are joined to the rails **A14** defining rectangular openings **A17** with the rails **A14**. The insert comprises body **A1** having a perimeter **A2**, and brackets **C** project from the perimeter **A2** from diametrically opposite sides **A4** of the body **A1**. Each of the brackets **C** has a pair of opposed sidewalls **A5**.

Applicants should note that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claim 27, the openings **A17** are square (some are square and rectangular) and the insert is circular and has abutment surfaces (abutment surfaces are around the perimeter) formed on the perimeter **A2** on diametrically opposite sides of the body **A1** between the brackets **C** and equispaced from the brackets **C** about the perimeter **A2**.

Regarding claim 28, the openings **A17** are square and the insert is selected from the group consisting of circular, astroidal, diamond-shaped, and cross-shaped inserts.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krauser, 7,774.

Regarding claim 4, Krauser discloses, in Figure 1, an ornamental insert comprising a body **A1** having a perimeter **A2**, and brackets **n** projecting from the perimeter **A2** from diametrically opposite sides **A4** of the body **A1**. Each of the brackets **n** has a pair of opposed sidewalls **A5**. The body **A1** has abutment surfaces **A6** formed on the perimeter **A2** on diametrically opposite sides **A7** of the body **A1** between the brackets **n** and equi-spaced from the brackets **n**. However, Krauser discloses the abutment surfaces **A6** being rightward and leftward and the brackets **n** projecting vertically from the perimeter. Applicants should note that the limitations “upwardly” and “downwardly” are relative terms that orienting the insert 90 degrees from vertical will place the abutment surface upward and downward and the bracket will project horizontally from the perimeter.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hainsworth, 386,124.

Regarding claim 21, Hainsworth as discussed, fails to disclose the insert being plastic. Applicants are reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the insert of plastic. *In re Leshin*, 125 USPQ 416.

Claims 15-19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spera, 4,805,879, in view of Hainsworth, 386,124.

Regarding claim 15, Spera discloses, in Figure 1, a picket fence comprising a substantially horizontally extending top rail **10**, a substantially horizontally extending intermediate rail **12**, and spaced substantially vertical pickets **A15** extending through the top rail **10** and the intermediate rail **12**. The top rail **10** has a bottom surface **20**. The intermediate rail **12** has a top surface (opposite to the bottom surface) and the intermediate rail **12** is spaced below and parallel to the top rail **10** and define rectangular spaces with the rails. However, Spera fails to disclose an ornamental insert comprising a body having a perimeter, an upwardly facing abutment surface, a downwardly facing abutment surface formed on the perimeter of the body, and brackets projecting outwardly and horizontally from the perimeter of the body; and each brackets having a pair of opposed sidewalls defining a u-shape.

Hainsworth teaches, in Figs. 1, 3, and 6, an ornamental insert to make an ornament fence. The insert comprises a body **A1** having a perimeter **A2** and brackets **C**. An upwardly facing flat abutment surface **A8** and a downwardly facing flat abutment surface **A9** are formed on the perimeter **A2**. The brackets **C** project outwardly and horizontally from the perimeter **A2** of diametrically opposite sides **A4** of the body **A1**. Each of the brackets **C** has a pair of opposed sidewalls **A5** defining a u-shape.

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Therefore, as taught by Hainsworth, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an ornamental insert to make the picket fence of Spera more decorative.

Regarding claim 16, the upwardly facing abutment surface **A8** is seated on the rail top surface **A10** and the downwardly facing abutment surface **A9** is in abutment with the top rail bottom surface **A11**.

Regarding claim 17, Hainsworth teaches the sidewalls **A5** are joined by a web **A12**.

Regarding claim 18, Hainsworth teaches each of the sidewalls **A5** overlaps a surface **A13** of one picket **A14** in a direction of a horizontally extending direction of the rails **A15** by a distance less than that one half of the dimension of the picket in the direction.

Regarding claim 19, Spera discloses the spaces are square and Hainsworth teaches the ornamental insert is selected from the group consisting of circular-shaped, astroidal-shaped, diamond-shaped, cross-shaped, and elliptical-shaped inserts.

Regarding claims 22 and 24, the insert and the picket fence are metal.

Regarding claims 23 and 25, Spera, as modified above, fail to disclose the insert and the picket fence being plastic. Applicants are reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the insert of plastic. *In re Leshin*, 125 USPQ 416.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30-5:30. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should



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you have questions on access to the Private PAIR system, contact the Electronic  
Business Center (EBC) at 866-217-9197 (toll-free).

*E.L.*

*Daniel P Stodola*

E.G.

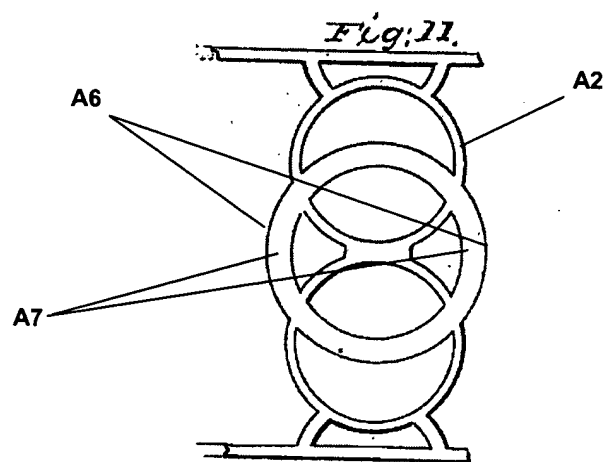
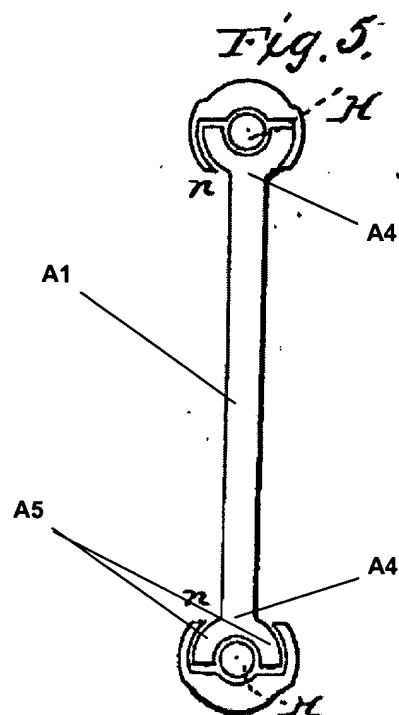
September 30, 2005

Attachments: one marked-up page of Krauser, 7,774  
one marked-up page of Hainsworth, 386,124

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

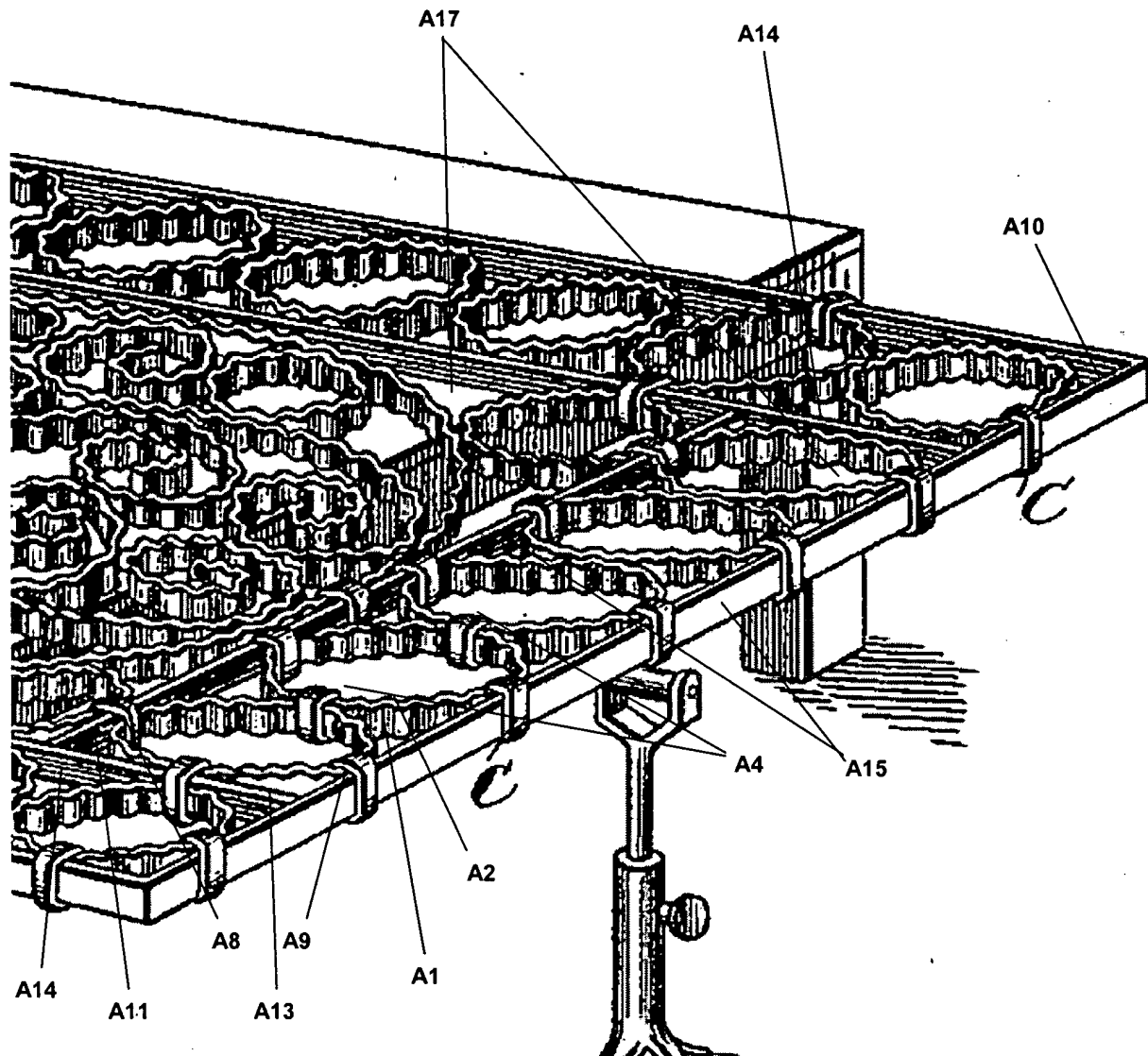
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Krauser, 7,774



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Hainsworth, 386,124



*Fig. 6.*

